

REMARKS

Applicants thank the Examiner for taking the time to speak with applicants' representative on July 28, 2005. Claims 1, 12, 15, and 17-19 have been amended. Claims 13, 14, and 16 have been canceled. Claims 1-12, 15, and 17-19 remain pending.

In the pending final Office Action, claims 12-19 were rejected under 35 USC 112, second paragraph, as being indefinite. The Examiner sets forth his understanding that there are two users and a document that may be local or remote to the users, and further states that it is not clear which of the two users, if either, constitutes the receiver. Only claim 15 now recites a receiver. Applicants respectfully traverse the Examiner's rejection. The claims recite a user and a receiver. Whether or not the receiver is a user does not affect whether the claim is definite, since there is a defined user and a defined receiver. The receiver can be the sending user or another entity without rendering the claim indefinite. Applicants remind the Examiner that the claims are to be read in light of the written description.

The Examiner also asserts that claims 12-19 are indefinite because they omit a structural cooperative relationship between the receiver and the user, the second user, and the optional server. Applicants respectfully traverse this assertion. Claim 15, which still claims a receiver, clearly recites the relationship between the receiver and the user – the user sends an email message to the receiver. The receiver can be the sending user or another user without rendering the claims indefinite. The structural relationship between the user and the server need not be recited to make the claims definite, particularly with respect to claims 12-18, which are method claims.

The Examiner also states that applicants are somehow improperly being their own lexicographers in using the claim term "receiver." Applicants respectfully traverse this assertion. The receiver as claimed in claim 15 can be "a person or object that receives," which is in accordance with the understood meaning of the term.

Applicants respectfully request that the Examiner withdraw the rejection under 35 USC 112, because the pending claims particularly point out and distinctly claim the subject matter that applicants regard as their invention.

Claim 12 was objected to for having the language “setting the receiver as a sending receiver.” The Examiner does not explain why he objects to this language. The language has been removed, and therefore the objection has been overcome and should be withdrawn.

Claims 1, 2, and 11-19 were rejected under 35 USC 102(e) as anticipated by Salam et al. (U.S. Patent No. 6,594,654). Claims 3-10 were rejected under 35 U.S.C. 103(a) as unpatentable over Salam in view of Christensen et al. (U.S. Patent No. 6,347,320). Claims 3, 14, and 16 have been canceled. Applicants respectfully traverse the rejections.

To establish a *prima facie* case of anticipation or obviousness, the Examiner must show that the references (individually in the case of anticipation rejection and in combination in the case of an obviousness rejection) teach or suggest each and every limitation of the claims. *See MPEP 2131; MPEP 2143*. Independent claims 1, 12, 15, and 17-19 all recite accepting a keyword, an identification of a document file, and a mail address (or identification of a receiver) from a user. Neither Salam nor the other prior art references of record teaches or suggests accepting a keyword, an identification of a document file and a mail address (or identification of a receiver) from a user. To the contrary, in Salam, the user does not identify a document file, but rather indicates a field of interest for a keyword search. Salam actually teaches away from requiring the user to identify a document file, because its purpose is to identify and locate files for the keyword search, so that the user does not have to investigate files himself. The same is true of Christensen. Thus, the references do not teach or suggest each and every limitation of claims 1, 12, 15, and 17-19, and the rejections should be withdrawn. Claims 2-11 depend from claim 1 and are therefore allowable for at least the same reasons.

In view of the above, each of the claims in this application is in condition for allowance. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing Attorney Docket No. 325772026100.

Dated: August 31, 2005

Respectfully submitted,

By 

Jill DeMello

Registration No.: 42,477
MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 300
McLean, Virginia 22102
(703) 760-7718